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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/043,846 | 01/11/2002 | Takaaki Shibata | 393032030000 | 1148 |

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| EXAMINER | |
|---|---|
| SMITH, CREIGHTON H | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2645 | |

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/043,846 | SHIBATA ET AL. | |
| | Examiner | Art Unit | |
| | Creighton H Smith | 2645 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4-13* is/are rejected.

7)☒ Claim(s) *3,14 and 15* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 6, 7, 9-13 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Application Publication #2004/0007120 to Futamase et al.

Futamase et al disclose in their Abstract a portable terminal that will play a music tone. In [0135], Futamase et al disclose that the terminal TS starts a request information send module (S1) and calls the base station, i.e., the server, through the terminal's transmitter (6), requesting the server base station to download information from the BS server's database. To be more specific, Futamase et al disclose, during talking with the server BS, music information, performance information, for example, stored in the server's database are displayed on the terminal's display (13). The user of the terminal will then operate keys on the terminal's keypad to enter numbers indicative of those pieces of information and then executes a request. Futamase et al disclose that their portable terminal is a telephone terminal [0001], i.e., a communication terminal capable of playing/sounding a musical tone, [0008]. In [0010], Futamase et al disclose a portable terminal comprising a "storage means" for storing music tone information, audio information, and video information, and a "generating means" for the audio and video information stored in the storage means. In [0014] Futamase et al disclose a

display means (13) that operates based on the word information (of the tone) and will generate a words display corresponding to the generated music tone. This means that the written words to a song will be displayed on a cell phone's LCD as the musical tones are emanating from the phone's speaker. In [0021], Futamase et al discloses the tone generating device that will play the stored music/tones in the cell phone's storage device. The data coming into Futamase et al cell phone is from the base station's server ion the form of streaming data, [0033]. Streaming data is sent over the Internet as disclosed in Newton's Telecom Dictionary, and hence is uploaded from Futamase et al server to the requesting cell phone's storage device.

Therefore, Futamase et al portable telephone terminal will display data associated with a musical tone, [0014]; their portable telephone has a device that will receive musical tone data via the Internet network because in order to "play" data along with its associated musical notes there must inherently be a device on the cell phone that receives the data. As mentioned supra, Futamase discloses in [0010] a storage means that will store musical, audio, & video information. Both the audio and video information meets applicant's limitation of storing a "predetermined program" in a program receiving device. Although Futamase et al never specifically discloses that their musical, audio, and video are stored in advance, it only seems inherent that if the music, audio, and video are stored at all, then they are stored in advance to when the user desires to view or hear the stored media means. If the user is storing melody tones along with the data to go along with the melody, so that when the cell phone receives a phone call the

melody will play along with the words being displayed on the phone's display, then the predetermined program, i.e., audio & video, is being stored in advance.

For claim 2, the first display data reads on any type of data being displayed on the phone's LCD display.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5, 8, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. publication #2004/0007120 to Futamase et al in view of U.S. publication #2002/87656 to Gargiulo et al.

Futamase et al does not disclose a server sending a java applet to the user's portable terminal. However, Gargiulo does disclose a server (530) sending a tune file to a specific mobile station using JAVA applets, [0166]. To have similarly used Gargiulo's teaching of sending a music file from a server to a mobile user's phone over the Internet in Futamase et al apparatus would have been obvious to a person having ordinary skill in the art, because someone with both references in front of them will realize that Futamase has not specifically disclosed how the file is transferred from Futamase et al server to the user's mobile phone and Gargiulo answers that question by sending the file via a JAVA applet.

Claims 3,14, 15, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of

the base claim and any intervening claims. Futamase et al nor any of the rest of the prior art teach the display area on the user's mobile phone having a second data display that represents a list of "occasionally updated phone data". Neither does the prior art teach that the predetermined programs are stored in the cell before the musical tone data is received from the server.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kamba and Kita et al.

Any inquiry concerning this communication should be directed to Creighton H Smith at telephone number 571/272-7546.

20 APR '05

Creighton H Smith
Primary Examiner
Art Unit 2645